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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,483	03/26/2004	Anthony William Wiley	DAVI202.001PUS	9152
20995	7590	04/11/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			HAAS, WENDY C	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			1661	

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/811,483	WHILEY ET AL.	
	Examiner	Art Unit	
	Wendy C. Haas	1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. § 102(b) as being anticipated by Australian (AU) plant breeder's rights (PBR) application 1998018, and grant number 1983, both made more than one year prior to the filing date of the instant application. Applicant provided copies of the published application and grant in the Information Disclosure Statement filed September 21, 2004. Both the application and grant indicate that the claimed plant was first sold in Australia in 1998. As such, the application and grant are enabled publications because they describe the claimed plant and because the claimed plant was publicly available, and thus reproducible. Use of this type of 102(b) rejection has been approved by the Court of Appeals for the Federal Circuit. *See, e.g., In re Elsner*, 72 USPQ2d 1038 (Fed. Cir. 2004).

Claim 1 remains rejected under 35 U.S.C. § 102(b) as being anticipated by the Queensland Government announcement of Dr. Tony Whiley's retirement in view of AU PBR 1983 and further in view of Applicant's remarks made March 26, 2004 indicating that propagating material was commercialized by One Harvest and its sub-licensees as early as November of 1999. The announcement, published February 15, 2002, discloses the claimed plant, 'B74', as "the latest mango taste sensation". AU PBR 1983 is provided as extrinsic

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evidence that the characteristics of the claimed plant were known in the art and that the claimed plant was publicly available more than one year prior to the instant application for patent.

Applicant's remarks confirm that commercial use was made of the claimed plant; there is no evidence provided to indicate that any member of the public could not seek to become a sub-licensee growing the claimed plant. Use of this type of 102(b) rejection has been approved by the Court of Appeals for the Federal Circuit. *See, e.g., In re Elsner*, 72 USPQ2d 1038 (Fed. Cir. 2004).

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Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure remains objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical

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description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

B. Applicants' description of FIG. 1 refers to 'Kensington Pride' as illustrated on the left and 'R2E2' as illustrated on the right, however the photographs are arranged vertically.

Applicants should amend this recitation to clearly indicate which variety is on top and which is on the bottom. Applicant's asserted in response to the first Office action that the intent was to have the drawing arranged from left to right, however, as the drawing rules state, the short side of the page will be printed at the top, and consequently the fruit will be arranged vertically on the printed patent. Correction is needed.

C. Applicants are requested to disclose whether the parent, rootstock and/or comparison cultivars 'Sensation', 'Kensington Pride', 'R2E2' and 'Keitt' have been patented in the United States, are currently the subject(s) of a pending U.S. plant patent application(s), or are unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, -(unpatented)-- should be inserted after the cultivar name, or such could simply be acknowledged in applicants' next response. Applicant's disclosed the information requested in response to the previous Office action, but have not incorporated the information into the Specification.

F. Page 3, lines 14 and 15, applicant recites: "The predominant skin color of ripe fruit of the new mango tree cultivar is red and yellow, while the predominant skin color of ripe fruit of

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‘Kensington Pride’ is yellow and red.” Red and yellow does not appear to be different or distinguishing from yellow and red. Further explanation or clarification of this supposedly distinguishing characteristic is needed. The same is true of the comparison of skin color between the claimed cultivar and ‘R2E2’ set forth on page 3, line 31 and page 4, lines 1 and 2 and the comparisons between the claimed plant, ‘Kensington Pride’ and ‘R2E2’ set forth in Table 1. Applicant’s did not provide a response to this objection.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Response to Applicant’s Arguments

Applicant argues that the availability of the claimed plant in Australia to One Harvest and its licensees as early as November of 1999 does not constitute public availability of the claimed plant. The Examiner has considered this argument but does not find it to be persuasive. A company may choose to make a plant available to the public through licensing and sub-licensing agreements, as is frequently the case with proprietary fruit trees. No indication has been made in Applicant’s arguments that any interested member of the public would NOT be able to obtain a sub-license. Further, even if such were the case, the sub-licensees who did acquire a sub-license are the exact members of the public who are consumers of fruit trees. Finally, there is no indication that another member of the public could not obtain bud wood from a sub-licensee.

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Accordingly, it appears that the claimed plant was publicly available in Australia more than one year prior to the filing date of the instant application for patent.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy C. Haas whose telephone number is (571) 272-0976. The examiner can normally be reached on Monday through Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. C. Haas

WENDY HAAS
PATENT EXAMINER

A handwritten signature in black ink that reads "Wendy Haas". The signature is written in a cursive, flowing style with a long horizontal stroke at the end.